

Remarks

Claims 141-152, 163-174, 176-183 and 186-192 are pending in the Application.

Claims 141-152, 163-174, 176-183 and 186-192 are rejected.

Claims 151-152 are cancelled herein without prejudice and re-presented as new Claims 195-196, respectively.

I. REJECTIONS UNDER OBVIOUSNESS-TYPE DOUBLE PATENTING

Examiner has rejected Claims 141-152, 163-174, 176-183 and 186-192 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,790,425, “Macroscopic Ordered Assembly of Carbon Nanotubes.” (“the ‘425 Patent”). Final Office Action, at 2. Examiner contends that “although the conflicting claims are not identical, they are not patentably distinct from each other because they [claim a] common subject matter – given that SWNTs self-assemble.” *Id.*

Applicant respectfully traverses these rejections, including for the reasons asserted in its Amendment Under 37 C.F.R. § 1.111, filed October 12, 2004, (the “1.111 Amendment”) at 7-10. However, to facilitate prosecution of the Application, Applicant hereby responds with the enclosed Terminal Disclaimer to moot these rejections. Applicant notes that, by filing this terminal disclaimer, it is not admitting the obviousness of the later filed claimed invention claimed in the ‘425 Patent in light of the earlier filed disclosure of the present Application. *Quad Environmental Tech. v. Union Sanitary Dist.*, 946 F.2d 870, 874, 20 U.S.P.Q.2d 1392, 1394 (Fed. Cir. 1991). Rather, “the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection.” *Id.*, 946 F.2d at 874, 20 U.S.P.Q.2d at 1394-95. And, it is with that understanding Applicant has filed the terminal disclaimer.

Therefore, in view of the foregoing, Applicant respectfully requests that the Examiner withdraw his rejection of Claims 141-152, 163-174, 176-183 and 186-192

under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-19 of the ‘425 Patent.

II. CLAIM RE-PRESENTATION

Examiner notes “that claims 151, 152 have two status identifiers – they are (mistakenly) listed as cancelled. These claims should be cancelled and re-presented as numbered 195 and 196.” Final Office Action, at 2.

Applicant apologizes for any confusion it may have caused by providing two inconsistent status identifiers, particularly since the latter mistakenly identified Claims 151-152 as being cancelled. As reflected in the remarks section of the 1.111 Amendment, it was not the intent of Applicant to cancel either of Claims 151 and 152. *See, e.g.*, 1.111 Amendment, at 7. Applicant appreciates the Examiner’s recognition of this inconsistency and the Examiner’s directive as to how Applicant should proceed. Thus, in accordance with the Examiner’s directive, Claims 151 and 152 have been cancelled herein and re-presented as new Claims 195 and 196, respectively.

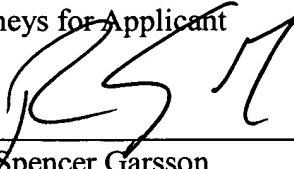
III. CONCLUSION

As a result of the foregoing, Applicant asserts that the Claims in the Application are now in a condition for allowance, and respectfully requests allowance of such Claims.

Applicant respectfully requests that the Examiner call Applicant’s attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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